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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,617	04/16/2004	Brian Dean Heikes	06975-469001 / AOL 229	7887
26171	7590	06/24/2008	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			HARRELL, ROBERT B	
		ART UNIT	PAPER NUMBER	
		2142		
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		06/24/2008		PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/825,617	HEIKES ET AL.	
	Examiner	Art Unit	
	Robert B. Harrell	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 April 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-53 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-53 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 16 April 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20060103&20051130</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

1. Claims 1-53 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks ™, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-53 are rejected under 35 U.S.C. 101 because the claimed invention, in light of the specification, encompasses non-statutory subject matter since such reads on (encompass) software or program per se' (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106 (New EXAMINATION GUIDELINES FOR COMPUTER-RELATED INVENTIONS). ". Per the system claims, such encompass only software or program per se' equivalents; unlike "A hardware system"; the applicant is reminded that an Operating System is software and/or program per se'. Per the computer program stored on a computer readable medium, such encompasses a carrier wave or transmission medium (carrier waves store data for the duration of transmission over a period of time and is thus storage); unlike a "hardware computer readable program storage medium". Also, such computer program claims are in the alternative with the use of "or" and thus encompasses only propagated signal(s). As for the method claims, even though drafted as "A method", each of the recited elements encompass their software or program per se' equivalent thus, the whole of the method encompasses pure software or program per se'; unlike "A method executing on a hardware". Also, while a hardware device claim, with functional acts, may inherently encompass a corresponding method, the same does not hold in the reverse since a corresponding method is broader in scope and can encompass a scope void of any hardware

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

7. Claims 1-53 are rejected under 35 U.S.C. 102 (e) as being anticipated by Boss et al. (United States Patent Application Pre-Publication Number: US 2004/0154022 A1).

8. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

9. Per claim 1, Boss taught a system (e.g., see Title) to manage instant messages (e.g., see Title), the system comprising:

- a) an input interface configured to receive instant messages created by or on behalf of one or more message sources for delivery to an intended recipient (e.g., see Abstract, figure 4, figure 8, and paragraph [0008], paragraph [00012], and paragraph [0014]- et seq.);
- b) a screening (i.e., filtering) component configured to identify, from among the received instant messages, qualifying instant messages that satisfy a capture rule, and to capture as captured instant messages two or more of the qualifying instant messages (e.g., see Abstract, figure 4, figure 8, and paragraph [0008], paragraph [00012], and paragraph [0014]- et seq. [*note, the system does not halt after screen the first message and thus “two or more”*]); and,
- c) an output interface configured to inform the intended recipient unobtrusively of the captured instant messages and to enable the intended recipient to manage the captured instant messages (e.g., see Abstract, figure 4, figure 8, and paragraph [0008], paragraph [00012], and paragraph [0014]- et seq.).

10. Per claim 2, claim 3, claim 4, claim 5, and claim 6, the list (e.g., see paragraph [0010]) was composed of at least one, the user who set the context based on a degree of separation and on desired context (unsolicited marketing messages were not normally desired in instant messaging or email (SPAM)) per paragraph [0012] rather than undesired content form known (heuristic) senders based on their statistical probability (Bayesian) of sending junk messages

11. Per claim 7, claim 8, claim 9, claim 10, claim 11, claim 12, claim 13, claim 14, claim 15, claim 16, claim 17, claim 18, claim 19, claim 20, claim 21, claim 22, claim 23, claim 24, and

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claim 25, see Abstract for time and category (i.e., from (un)known senders or (un)known sources (i.e., use of wild card "*" for unknown and trusted for known)) related filtering of messages based on recipient's calendar which messages can be ignored (e.g., see figure 3 (305)), blocked (also figure 3 (305)), or captured (saved in figure 3 (310)), and the figures for the recipient responding to messages or deleting any of the messages by implementing information related to the message source associated with the capture instant message per figure 5B. The rules could be modified per figure 4 such that future messages from a source were not captured (stored) or blocked or deleted (with a beep noise) without stealing the users attention (i.e., deletion is performed in the background).

12. Per claims 26-53, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.

13. **A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Thursday from 5:30 am to 2:00 pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (571) 273-8300.

16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

/Robert B. Harrell/
ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142